#39

Official
DRB

PATENT
Customer No. 22,852
Attorney Docket No. 1147.0142

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of: U.S. Patent No. 5,750,338 Mark L. Collins et al. Reissue Serial No.: 09/533,906 Filed: March 8, 2000 TARGET AND BACKGROUND CAPTURE METHODS WITH AMPLIFICATION FOR AFFINITY ASSAYS	Group Art Unit: 1655 Examiner: D. JOHANNSEN

REISSUE LITIGATION BOX
Commissioner for Patents
Washington, DC 20231

Sir:

UPDATED NOTICE OF RELATED LITIGATION

Further to the Patent Owner's submission of February 21, 2002, the Patent Owner brings to the attention of the Office the following papers reflecting the current state of the case following a jury verdict rendered on May 22, 2002:

- Transcript of Jury Verdict, May 22, 2002 ("Transcript");

- Judgment for Gen-Probe on its Declaratory Action of Non-infringement and Invalidity; and

- Order (1) Denying Gen-Probe's and Vysis's Pre-Verdict Motions for Judgment as a Matter of Law, and (2) Setting Briefing Schedule for Post-Trial Motions ("Order").

The jury rendered a verdict that the original patent claims were not infringed and were invalid for obviousness and lack of enablement. The jury rendered "advisory" verdicts that the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

claims had been inequitably procured and were unenforceable for prosecution laches. Vysis believes that the jury verdict was incorrect and has moved for judgment as a matter of law and for a new trial.

To put these papers in context requires a brief explanation. In any jury trial, certain issues are decided by the jury and certain others are reserved for the court. Specifically, traditional "legal" issues are decided by the jury, while "equitable" issues are decided by the court. In patent litigation, infringement and the affirmative defense of invalidity are legal issues (provided damages are sought) and thus, are decided by a jury. *See TegalCorp. v. Tokyo Electron America, Inc.*, 257 F.3d 1331, 1341, 59 U.S.P.Q.2d 1385, 1391 (Fed. Cir. 2001). In contrast, inequitable conduct is an equitable issue and as such is reserved for the court to decide. *See Paragon Podiatry Laboratory v. KLM Laboratories,* 984 F.2d 1182, 1190, U.S.P.Q.2d 1561, 1568 (Fed. Cir. 1993). The judge may submit an equitable issue, such as inequitable conduct, to the jury for an "advisory verdict," as the court did in this case. *See* FED. R. CIV. P. 39(c). However, an advisory verdict has no binding effect on the court, but only provides guidance. *See Carbide Blast Joints, Inc. v. Vermont American Corp.*, 1995 U.S. App. LEXIS 33800 at 9-11 (Fed. Cir. 1995); *Hamm v. Nasatka Barriers, Inc.*, 166 F.R.D. 1, U.S. Dist. LEXIS 3445 (D.D.C. 1996) ("An advisory verdict has no force, other than persuasive, on the court, which remains the sole and final decision-maker."). Thus, the court still must undertake its own separate analysis of the inequitable conduct issues, and the Transcript notes at page 1784, lines 24-25, the court's view that "I think Gen-Probe is going to have the laboring oar on that."

The substance of the allegations upon which the jury verdict was based have already been made of record through the Patent Owner's prior Notices of Related Litigation. The judgments entered on non-infringement and invalidity are not yet final, appealable judgments under Rule

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

54(b), Fed. R. Civ. P., because there remain other claims in the case upon which judgment has not been entered. Moreover, as set forth in the Order, the court set a briefing schedule for Vysis's motions for judgment as a matter of law under Rule 50, Fed. R. Civ. P., and for a new trial under Rule 59, Fed. R. Civ. P. Only after those motions are ruled upon and judgment is entered on all claims in the case will any judgment be ripe for appeal. Rule 4(a)(4)(A), Fed. R. App. P. Accordingly, the Patent Owner believes that the events reflected in the papers submitted with this Updated Notice should not affect reissuance of this patent. *See, e.g., Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 1135-36, 227 U.S.P.Q. 543, 545-46 (Fed. Cir. 1985) (no collateral estoppel affect on reissue where judgment on original patent has not been reviewed on appeal).

If there is any fee due in connection with the filing of this Notice, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Date: June 11, 2002

By: Jean Burke Fordis
Jean Burke Fordis
Reg. No. 32,984

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE INCORPORATED,	)	Civil Action
	)	NO. 99CV2668-H
Plaintiff,	)	San Diego, California
	)	May 22, 2002
v.	)	4:30 p.m.
	)	
VYSIS, INC.,	)	JURY TRIAL
	)	
Defendant.	)	VOLUME X
	)	Pages 1780-1787

D A I L Y C O P Y

REPORTER'S TRANSCRIPT OF PROCEEDINGS

THE HONORABLE MARILYN L. HUFF, PRESIDING

APPEARANCES:

For the Plaintiff:
STEPHEN P. SWINTON, ESQ.
J. CHRISTOPHER JACZKO, ESQ.
COOLEY GODWARD
4401 Eastgate Mall
San Diego, CA 92121

For the Defendant:
CHARLES E. LIPSEY, ESQ.
THOMAS W. BANKS, ESQ.
L. SCOTT BURWELL, ESQ.
FINNEGAN HENDERSON FARABOW
GARRETT and DUNNER
1300 I Street N.W., Suite 700
Washington, D.C. 20005

Reported by:
Linda S. Nelson, RMR, CRR
Official Court Reporter
940 Front Street, Box 18
San Diego, CA 92101
Telephone: (619) 696-7559

Proceedings reported in stenotype.
Transcript prepared by Computer-Aided Transcription.

PROCEEDINGS

(In session at 4:30 p.m.)

THE COURT: It is so empty here without all the boxes.

I'm informed that the jury has a verdict.

THE CLERK: Number 1 on calendar, 99CV2668, Gen-Probe Incorporated v. Vysis, Inc., on for jury trial, tenth day.

JUROR: Same spots?

THE COURT: Same spots.

(Jury present)

THE COURT: Now, logistically, do you have the phone number we could call for you and say that --

JUROR: Yeah. Can you do that for me?

THE COURT: Sure.

JUROR: 619-925-7083. Supposed to meet her like right now out in front.

THE COURT: Members of the jury, have you reached a verdict? Do you want to hand the verdict to my bailiff?

THE CLERK: United States District Court, Southern District of California. Gen-Probe Incorporated, Plaintiff, v. Vysis, Inc., Defendant, case number 99CV2668-H(AJB), SPECIAL VERDICT.

A. INFRINGEMENT

1. Has Vysis, Inc. ("Vysis") proved by a preponderance of the evidence that Gen-Probe Incorporated ("Gen-Probe")

infringes the '338 patent under the doctrine of equivalents?

No.

2. Identify any claims of the '338 patent that Vysis has proved are infringed under the doctrine of equivalents.

No claim is marked.

B. INVALIDITY

3. Has Gen-Probe proved by clear and convincing evidence that any or all of the claims of the '338 patent are invalid on the ground of obviousness?

Yes.

4. Identify any claims of the '338 patent that Gen-Probe has proved are invalid on the ground of obviousness.

All.

5. Has Gen-Probe proved by clear and convincing evidence that any or all of the claims of the '338 patent are invalid on the ground of lack of enablement?

Yes.

6. Identify any claims of the '338 patent that Gen-Probe has proved are invalid on the ground of lack of enablement.

All.

7. Has Gen-Probe proved by clear and convincing evidence that Vysis abandoned the invention claimed in the '338 patent?

No.

C. EQUITABLE CONDUCT

8. Has Gen-Probe proved by clear and convincing evidence

that Vysis misrepresented or failed to disclose material facts to the United States Patent and Trademark Office ("PTO") with the intent to deceive the PTO?

Yes.

9. Has Gen-Probe proved by clear and convincing evidence that Vysis deliberately and unreasonably delayed the prosecution of the '338 patent?

Yes.

The foreperson should sign and date this document. The date is 5-22-02 and the foreperson is --

THE COURT: Name?

JUROR: Matthew Dicori.

THE CLERK: Ladies and gentlemen of the jury, is this verdict, as presented and read, the verdict of each of you, so say you all?

JURORS: (Collective affirmation).

THE COURT: Would you like the jury polled?

MR. LIPSEY: No, Your Honor, we're content.

THE COURT: All right. Thank you. Well, you have finished your job and now there is some additional work that the Court will have to do with the parties. I did say at the beginning that I thought you would find that it is a very interesting case, and this is really the -- just the beginning of the technology in this area. And we're going to hear a lot more about all the biotechnology as the matters are invented

and discovered. It is a fascinating case, and I did think that both jobs did a wonderful job in the presentation.

You're free from your admonition. You're free to talk to the parties about the case. Whatever you say may be used for purposes of appeal. It may be put into a declaration form. You're not required to talk to them, if you don't want to.

You should check out with the jury room first. And then, if the parties want to talk to you, then you can talk to them outside the jury room because they need to go check out.

I do want to thank you for all the time and attention that you've given to this court. You're free to go.

THE CLERK: Yes, they can go downstairs.

THE COURT: The notebooks are -- you can take that, if you want, the patent notebook.

(Jurors dismissed)

THE COURT: If you wish, you can go downstairs and talk to them and then come back, if you want to do that. No?

MR. LIPSEY: I would just as soon get our business straight here, if it's all right with you. I don't know how Mr. Swinton feels.

MR. SWINTON: That would be my preference. I have one of my colleagues down there.

THE COURT: All right. The Court said that it would set a briefing schedule. And on the inequitable conduct, I think Gen-Probe is going to have the laboring oar on that. I,

frankly, thought that Vysis had a pretty good chance at getting an answer yes to question number 1.

So each of you have filed motions. My law clerk will send you out a briefing schedule. Is that fine?

MR. LIPSEY: If I might plead, I guess, there is a lot here obviously. If the Court could be generous in the time to give us time to deal with it, we would certainly appreciate that.

THE COURT: All right. Well, how much time are you thinking? Because we have a change in law clerks and a conflict with the next law clerk coming in on this issue. It really does need to be over and done with by mid August completely.

MR. LIPSEY: I would like to formally move for JMOL and also for a new trial. Plus, if there are any questions, that we have timely done it.

THE COURT: Yes.

MR. LIPSEY: And in terms of the briefing schedule, for getting papers in on that, if we could have four weeks on that, I think that would be ample for us to recover and to get the papers in. And I would hope --

THE COURT: We'll consider that and then send out a briefing schedule that will get it all done. But we really do need to have it all finished and wrapped up, and that should give everybody plenty of time to do that.

MR. LIPSEY: Thank you.

THE COURT: All right. Thank you. Anything else?

MR. SWINTON: Nothing for our side.

THE COURT: All right. Thank you. I do want to compliment the parties. It has been a pleasure to have you in my court.

MR. LIPSEY: We would like to thank the court and, particularly, the court staff, who has been very accommodating to us. We very much appreciate it.

MR. SWINTON: We do. Thank you.

THE COURT: As an aside, I do think that the reissue is alive and well and so we may see you back and probably we'll see you back. And obviously there is a number of issues that remain to be litigated under the special verdict. It puts both things in play again.

MR. SWINTON: Thank you, Your Honor.

THE COURT: All right. Thank you.

THE CLERK: We're in recess.

(Proceedings concluded at 4:40 p.m.)

CERTIFICATE

I, Linda S. Nelson, Official Court Reporter for the Southern District of California, do hereby certify:

That the foregoing is a true and correct transcript of the proceedings had in the above-entitled action; that I reported same in stenotype, being the duly appointed, qualified and acting official court reporter, to the best of my ability; and thereafter transcribed same into typewriting through Computer-Aided Transcription.

Date: May 22, 2002

Linda S. Nelson, RMR, CRR
Official Court Reporter

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE INCORPORATED,

Plaintiff,

vs.

VYSIS, INC.,

Defendant.

CASE NO. 99-CV-2668 H (AJB)

JUDGMENT FOR GEN-PROBE INCORPORATED ON ITS DECLARATORY ACTION OF NON-INFRINGEMENT AND INVALIDITY

This action came before the Court for a trial by jury on May 7, 2002. The issues have been tried and the jury has rendered the following special verdict on May 22, 2002:

A. INFRINGEMENT

1. Has Vysis, Inc. ("Vysis") proved by a preponderance of the evidence that Gen-Probe Incorporated ("Gen-Probe") infringes the '338 patent under the doctrine of equivalents?

The Jury answered: No.

2. Identify any claims of the '338 patent that Vysis has proved are infringed under the doctrine of equivalents:

The Jury answered: Not applicable.

////

////

B. INVALIDITY

3. Has Gen-Probe proved by clear and convincing evidence that any or all of the claims of the '338 patent are invalid on the ground of obviousness?

The Jury answered: Yes.

4. Identify any claims of the '338 patent that Gen-Probe has proved are invalid on the ground of obviousness:

The Jury answered: All.

5. Has Gen-Probe proved by clear and convincing evidence that any or all of the claims of the '338 patent are invalid on the ground of lack of enablement?

The Jury answered: Yes.

6. Identify any claims of the '338 patent that Gen-Probe has proved are invalid on the ground of lack of enablement:

The Jury answered: All.

7. Has Gen-Probe proved by clear and convincing evidence that Vysis abandoned the invention claimed in the '338 patent?

The Jury answered: No.

C. INEQUITABLE CONDUCT

8. Has Gen-Probe proved by clear and convincing evidence that Vysis misrepresented or failed to disclose material facts to the United States Patent and Trademark Office ("PTO") with the intent to deceive the PTO?

The Jury answered: Yes.

9. Has Gen-Probe proved by clear and convincing evidence that Vysis deliberately and unreasonably delayed the prosecution of the '338 patent?

The Jury answered: Yes.

In accordance with the Special Verdict filed on May 22, 2002, JUDGMENT IS ENTERED AS FOLLOWS:

As to infringement, judgment shall enter in favor of Gen-Probe Incorporated on its declaratory action of non-infringement of the United States Patent No. 5,750,338.

As to invalidity, judgment shall enter in favor of Gen-Probe Incorporated on its declaratory action of invalidity of United States Patent No. 5,750,338 based on obviousness and lack of enablement.

Because the jury verdict was advisory on the issues of unenforceability, the Court submits the judgment on inequitable conduct and prosecution laches.

IT IS ORDERED AND ADJUDGED.

DATED: 5/23/02

MARILYN L. HUFF, Chief Judge
UNITED STATES DISTRICT COURT

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE INCORPORATED,

Plaintiff,

vs.

VYSIS, INC.,

Defendant.

CASE NO. 99-CV-2668 H (AJB)

ORDER (1) DENYING GEN-PROBE INCORPORATED AND VYSIS, INC.'S PRE-VERDICT MOTIONS FOR JUDGMENT AS A MATTER OF LAW, AND (2) SETTING BRIEFING SCHEDULE FOR POST-TRIAL MOTIONS

Gen-Probe Incorporated ("Gen-Probe") has filed a declaratory judgment action against Vysis, Inc. ("Vysis"). The trial in this case commenced on May 7, 2002. During the trial, both Gen-Probe and Vysis filed motions for judgment as a matter of law under Federal Rule of Civil Procedure 50(a). Federal Rule of Civil Procedure 50(a) states in relevant part:

> If during a trial by jury a party has been fully heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue, the court may determine the issue against that party and may grant a motion for judgment as a matter of law against that party with respect to a claim or defense that cannot under the controlling law be maintained or defeated without a favorable finding on that issue

Fed. R. Civ. P. 50(a)(1). At the close of the evidence and all other appropriate times, the Court submitted the motions.

#42

99CV2668

The jury returned its special verdict on May 22, 2002. The jury found that the patent-in-suit was not infringed, was invalid based on obviousness and lack of enablement, and was unenforceable based on inequitable conduct and prosecution laches.

Having considered the evidence and the papers submitted to the Court in support of these pending motions, the Court denies all pending motions for judgment as a matter of law under Federal Rule of Civil Procedure 50(a).

The Court deems that the parties have renewed a motion for judgment as a matter of law after trial and have made a motion for new trial under Federal Rule of Civil Procedure 50(b). To address those post-trial motions, the Court sets the following briefing and hearing schedule:

(1) The parties' memorandum of contentions and facts in support of their renewed motions for judgment as a matter of law, along with the supporting lodgments, shall be filed and served no later than ***Monday June 17, 2002***. The opposition papers shall be filed and served no later than ***Monday July 1, 2002***. The reply papers shall be filed and served no later than ***Tuesday July 9, 2002***.

(2) The hearing on the post-trial motions is scheduled for ***Monday July 22, 2002***, at ***10:30 a.m.*** Unless otherwise notified by the Court, these motions are submitted on the papers without a hearing pursuant to Civ. L. R. 7.1(d)(1).

(3) Unless modified by this order, the parties shall comply with all the provisions of the Civil Local Rules, including Civ. L. R. 7.1(h).

IT IS SO ORDERED.

DATED: 5/23/02

MARILYN L. HUFF, Chief Judge
UNITED STATES DISTRICT COURT

Copies to:

Stephen Swinton
Cooley Godward LLP
4365 Executive Drive, Suite 1100
San Diego, CA 92121

Charles Lipsey
Finnegan, Henderson, Farabow, Garrett & Dunner
1300 I Street, N.W., Suite 700
Washington, D.C. 20005

Thomas W. Banks
Finnegan, Henderson, Farabow, Garrett & Dunner
245 First Street, 18th Floor
Cambridge, MA 02142

John H L'Estrange, Jr
Wright and LEstrange
701 B Street
Suite 1550
San Diego, CA 92101-8103

Jeffrey Weinberger
Munger Tolles & Olson LLP
355 South Grand Avenue, 35th Floor
Los Angeles, CA 90071-1560

LAW OFFICES
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
Stanford Research Park
700 Hansen Way
Palo Alto, CA 94304

Telephone
(650) 849-6600

Facsimile
(650) 849-6666

FACSIMILE TRANSMITTAL

TO	FROM
Name: Examiner Diana B. Johannsen	**Name:** Jean B. Fordis
Firm: USPTO	**Phone No.:** 650-849-6607
Fax No.: 703-746-5064	**Fax # Verified by:** jbf
Phone No.: 703-305-0761	**# Pages (incl. this):** 13
Subject: Reissue Appln of Collins et al.	**Date:** June 11, 2002
Your File No.: Appln No. 09/533,906	**Our File No.:** 01147-0142

Confirmation Copy to Follow: No

Examiner Johannsen:

As we discussed, attached is the Updated Notice of Related Litigation, enclosing the following:

- Transcript of Jury Verdict, May 22, 2002;

- Judgment for Gen-Probe on its Declaratory Action of Non-infringement and Invalidity; and

- Order (1) Denying Gen-Probe's and Vysis's Pre-Verdict Motions for Judgment as a Matter of Law, and (2) Setting Briefing Schedule for Post-Trial Motions.

Thank you again for your willingness to consider this submission.

Jean Fordis

If there is a problem with this transmission, notify fax room at (650) 849-6600 or the sender at the number above.